

## **REMARKS**

Claims 1, 4-6, and 8-9 are present in the application, with claims 1 and 4-6 having been amended by the current response, claims 2- 3 and 7 having been cancelled and new independent claims 8-9 having been added by the current amendment.

Claims 1-2 and 7 stand rejected with claims and 3-6 being objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Objection to Drawings Under 37 CFR 1.84(p)(5)**

In the official action, the Examiner objected to the drawings by stating as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "a bone conduction microphone 4" in paragraph [0010]. Specifically, the examiner stated as follows:

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "a bone conduction microphone 4" in paragraph [0010].

2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In response to the Examiner's objection, applicant has added the reference sign in the drawings as suggested by the Examiner. Applicant believes such correction should obviate any objection that the Examiner may have and an action acknowledging same is respectfully requested.

### **Objection to the Disclosure Under 37 CFR 1.84(p)(5)**

In the official action, the Examiner objected to the disclosure by stating that paragraph [0002] [0010] describes both "a bone conduction microphone 4" and "a strap 4". The figures only appear to indicate "a strap 4" with no indication of "a bone conduction microphone".

In response to the Examiner's objection, applicant has provided an amendment to paragraph [0010], as suggested by the Examiner. Applicant believes such corrections should obviate any objection to the Examiner may continue to have and an action acknowledging same is respectfully requested.

### **Rejections under 35 USC 103 (a)**

As a preliminary matter, with respect to the 35 USC section 103 rejections, Applicant respectfully objects to the form of the Examiner's rejections. Instead of identifying the relevant portions of the references that allegedly anticipate or render Applicant's claimed invention obvious, and instead of providing reasoning or a basis for the rejections, the Examiner has merely identified individual elements in two applied references and made unfounded, general rejections under Section 103 based on all the references each individually. Further, the Section 103 rejections appear to provide no disclosure, suggestion or teaching as to how the references may be modified and, much less, any motivation for doing so. Applicant respectfully asserts that the form of the Examiner's rejections is improper and, and appeared to.

In the present official action, the Examiner rejected Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofer (US Patent 4,843,628 ('628)) as follows:

Claims 1-2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaakkola (WO 03/084192 ('192)) in view of Takeda (US Patent 6,957,049 ('049)).

**Regarding claim 1**, Jaakkola teaches a talking device (personal telecommunication device; '192 title), which is provided with a speaker (transducer; '192 Fig. 4-7 #412), a microphone ('192 Figs. 4-7 #413) and a wireless circuit (short time distance transceiver block; '192 Fig. 4-6 #331 *wherein* "short distance transceiver block 331 has...a wireless communication interface"; '192 page 15 lines 30-31) and capable of: fitting to its user's body (worn on the torso of a user; '192 page 4 lines 36-38).

Jaakkola **does not** explicitly teach the device connecting to a cell phone by wireless through said wireless circuit. Jaakkola also **does not** explicitly teach the speaker being a bone conduction speaker, nor the microphone being an air conduction microphone.

Jaakkola does teach a radio transceiver coupled to a main processor for arranging bidirectional radio communication between the device and a **digital cellular radio network**. Jaakkola also teaches the amulets can be used as an accessory to otherwise complete mobile telephones using Bluetooth® for the benefit of allowing the user to modularly add the device to an existing cell phone.

**In have been obvious to one of ordinary skill in the art at the time of the invention to modify the talking device as taught by Jaakkola by using Bluetooth® technology to connect it to a complete mobile telephone for the benefit of allowing a user to modularly add the device to an existing cell phone.**

In the same field of endeavor, Takeda teaches a mobile communication unit with a bone conduction speaker ('049 Fig. 1 #1) and an air conduction microphone ('049 Fig. 1 #3 and "microphone portion 3...being disposed adjacent to the user's mount...to sufficiently catch the user's voice sound"; '049 col. 3 lines 18-23) for the benefit of allowing a user to listen sufficiently in a noisy place ('049 abstract).

**It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the speaker as taught by Jaakkola by making it bone conducting as taught by Takeda for the benefit of allowing a user to listen sufficiently in a noisy place.**

**Regarding claim 2,** Jaakkola and Takeda remain as applied above.

Jaakkola further teaches both said speaker ('192 Fig. 4b #412) and said wireless circuit ('192 Fig. 4b #331) are packed in a head portion of an ornamental pendant ('192 Fig. 4 #401).

**Regarding claim 7,** Jaakkola and Takeda remain as applied above.

See rejection of claim 1, where Jaakkola makes obvious the connection between the wireless circuit and a cell phone.

### **Allowable Subject Matter**

Claims 3-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In that regard, applicant wishes to thank the Examiner for indicating that claims 3-6 were allowable if rewritten in independent form including all of the limitations of the base claim in any intervening claims.

Regardless of the above, and solely to expedite prosecution without intending to alter the scope of the claims, Applicant has herein amended independent claim 1 to incorporate the subject matter of canceled dependent claims 2 and 3, as suggested by the Examiner and converted claim 7 into an independent claims 8 and 9 to make explicit that which was implicit. Specifically dependent claim 1 has been amended to recite that the bone conduction device is “...A device capable of being fitted to a users body comprising: a bone conduction speaker, an air conduction microphone and a wireless circuit, the device being capable of connecting to a cell phone by wireless through the wireless circuit wherein both the bone conduction speaker and the wireless circuit are packed in a head portion of an ornamental pendant and the air conduction microphone is contained in a buckle portion; and the buckle portion serves to connect the head portion of the pendant with a

strap. Support for these amendments can be found in paragraphs [0006], [0007], [0009] and [0010] of the specification.

Thus, independent claim 1 has been amended to more clearly distinguish over the Examiner's asserted combination in that the relied upon reference fail to disclose, suggest or teach a device comprising the above recited structure.

Original dependent claim 7 has been canceled and rewritten as new independent claims 8 and 9 to incorporate some of the material from original dependent claims 2-3 and original independent claim 1. Specifically, independent claims 8 and 9 now read in part as follows: "... wherein the device is capable of operatively linking the wireless circuit to a cell phone."

Thus, original dependent claim 7 has been canceled and put in independent form as independent claims 8 and 9. Since original dependent claim 7 been incorporated into independent claims to more clearly distinguish over the Examiner's asserted combination in that the relied upon reference fail to disclose, suggest or teach a device comprising the above recited structure, applicant respectfully submits that independent claims 8 and 9 are now in condition for allowance and an action acknowledging same is respectfully requested.

Regardless of the above, and solely to expedite prosecution without intending to alter the scope of the claims, Applicant has herein independent amended claim 1 to make explicit that which was implicit. Namely, independent claim has been amended to recite that the device is capable of being fitted to a users body comprising: a bone conduction speaker, an air conduction microphone and a wireless circuit, the device being and capable of connecting to a cell phone by wireless through the wireless circuit wherein both the bone conduction speaker and the wireless circuit are packed in a head portion of an ornamental pendant and the air conduction microphone is contained in a buckle portion; and the buckle portion serves to connect the head portion of the pendant with a strap.. Support for these amendments can be found in paragraphs [0007], [0008], [0014] and [0018] of the specification.

If you are the above, applicant respectfully submits that amended independent claim 1 distance than is in condition for allowance and an action acknowledging same is respectfully requested.

### **Examiner Must Provide Specific Reasons to Support Obviousness Rejection**

As the Examiner knows, In *Ex parte Humphreys*, the patent application involved the isolation of genes for biosynthesis of polyketide antibiotics. The Examiner rejected various claims under Section 103 as unpatentable over a Malpartida 1984 reference in view of a Rose reference.

On appeal, the Board reversed the Examiner because the references failed to suggest the claimed invention. Specifically, the Board held that the Examiner had **failed to establish sufficient information to support the requirement that the claimed invention would appear to have been obvious in view of the prior art**. [Emphasis provided] In this connection, the Board stated the following:

We reverse this rejection. . . . The examiner's rejection is **not specific** as to how one of ordinary skill in the art would have found it obvious to practice any specific method within the scope of these claims as of the filing date of this application. In this regard, we note that the examiner **has not explained with any specificity on this record** how Rose, either as discussed on page 2 of the present specification or from a consideration of the entire reference as supplied by appellants, **would have suggested in combination** with Malpartida 1984 the methods set forth by these claims. [Emphasis provided]

Thus, *Humphreys* teaches that if the Examiner does not provide specific reasons to support the obviousness rejection, he or she will have failed to establish a prima facie case of obviousness, and the application will be, allowed over the prior art.

In this particular application, the Examiner, like in *Humphreys*, has failed to provide sufficient information to support the requirement that the claimed invention would appear to have been obvious in a few of the prior art. Specifically, the Examiner stated as follows "... **In have been obvious to one of ordinary skill in the art at the time of the invention to modify the talking device as taught by Jaakkola by using Bluetooth® technology to connect it to a complete mobile telephone for the benefit of allowing a user to modularly add the device to an existing cell phone.**" The Examiner has not explained with any specificity on the record how Takeda **would have suggested in combination** with Jaakkola the methods set forth by the amended and new claims and an. Action acknowledging same is respectfully requested

### Apparent Rejections under “Personal Knowledge”

Concerning the Examiners further rejection of the above claims for being ". . . obvious to one of ordinary skill in the art at the time of the invention to modify the talking device as taught by Jaakkola by using Bluetooth® technology to connect it to a complete mobile telephone for the benefit of allowing a user to modularly add the device to an existing cell phone” and “. . . obvious to one of ordinary skill in the art at the time of the invention to modify the speaker as taught by Jaakkola by making it bone conducting as taught by Takeda for the benefit of allowing a user to listen sufficiently in a noisy place." This reasoning appears to be similar to rejection for "being a matter of design choice" and the taking of “official notice.” Applicant believes that the amendments have obviated not only the Examiners prior art rejections but also obviated the Examiner's reasoning based on being similar to personal knowledge, when the Examiner states that specific information that is needed to support the obviousness rejection is obvious to one of ordinary skill in the art or is similar to "as a matter of design choice" and the taking of “official notice.”

In that regard, concerning the Examiner's unsupported assertion that "...obvious to one of ordinary skill in the art at the time of the invention to modify the talking device as taught by Jaakkola by using Bluetooth® technology to connect it to a complete mobile telephone for the benefit of allowing a user to modularly add the device to an existing cell phone” and “. . . obvious to one of ordinary skill in the art at the time of the invention to modify the speaker as taught by Jaakkola by making it bone conducting as taught by Takeda for the benefit of allowing a user to listen sufficiently in a noisy place.”, which is similar to the taking of “official notice”, applicant respectfully requests that the Examiner provide an affidavit supporting these unfounded assertions, as is required upon request of the applicant.

It is applicant's position that the above are clearly unsupported conclusions - not reasons on which to base rejections and appeared to be another form of personal knowledge (other than the taking of official notice) is when the Examiner states that specific information that is needed to support the obviousness rejection is obvious to one of ordinary skill in the art or is similar to a matter of "design choice" rejection. That is, the Examiner is missing specific information and relies on general knowledge in the prior art that the Examiner assumes would teach the missing subject matter. The Examiner must provide sufficient reasoning to substantiate the claim of obvious design choice.

As the Examiner may know, a bald statement very similar to the Examiner's was addressed by the PTO Board of Patent Appeals and Interferences in In re Garrett, 33 BNA PCTJ 43 (November 13, 1986). The Board, in reversing an Examiner's similar, but legally untenable alleged

rejection, held that the Examiner's assertion that the modification proposed was ... "an obvious matter of engineering design choice was an unsupported conclusion -- not a reason upon which to base the rejection". [See also In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977), Carl Schenck, A.G. - v. Norton Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) and Carman Industries v. Wahl, 774 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983)]. Applicant finds no disclosure, suggestion or teaching in the combined applied references which would suggest to one skilled in the relevant art to combine the specific features mentioned above, as claimed in the present application.

In a later example relating to "design choice", in In re Chu, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995), the invention related to an apparatus used to control or filter emissions, such as sulfur oxides, oxides of nitrogen, and particulates (such as fly ash), from fossil fuel boilers. The Examiner was of the opinion that the prior art showed all the features of the invention with the exception of a baghouse filter having a catalyst located within the filter. The applicant Chu argued that the prior art references did not teach or suggest the positioning of the catalyst inside the bag retainer of the filter bags. Chu maintained that this feature was significant because the bag retainer provided support and prevented the filter bags from collapsing during pulsejet cleaning. Chu provided technical evidence relating to, for example, the frailty of fabric filters during pulse-jet cleaning, and the violent "snapping" action during pulse-jet cleaning.

On appeal, the Board concluded that situating the catalyst within the bag retainer was a matter of "design choice" and affirmed the rejection. The Federal Circuit, however, reversed the rejection. The court emphasized that Chu's technical evidence militated against a conclusion that placement of the catalyst was merely a design choice. **Since the Board provided no specific reasoning to support the assertion of design choice**, the Federal Circuit reversed the rejection. (Emphasis added) Thus, **the Chu decision instructs that the Examiner must provide reasoning why a specific feature is a matter of design choice and therefore obvious to one of ordinary skill in the art.** (Emphasis added)

In a more recent case, In re Sang-Su Lee, 61 U.S.P.Q.2d 1430, the Federal Circuit spoke definitively concerning the requirement for "judicial review of a decision of the Board of Patent Appeals and Interferences denying an application for a patent by stating that any rejection must be founded on the obligation of the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's **reasoning** in reaching its conclusions." The Federal Circuit stated that **"...as applied to the determination of patentability vel non when the issue is obviousness, it is fundamental that the rejection of a patent application must be based on evidence comprehended by the language of the statute addressing obviousness."** (Emphasis added) The Federal Circuit went on to say that **"the patent examination process centers on prior art and the analysis thereof; when**

patentability turns on the question of obviousness, the search for an analysis of prior art includes evidence relevant to the findings of whether there is a teaching, motivation or suggestion to select and combine the references relied on as evidence of obviousness.” (Emphasis added) The Federal Circuit further stated that “in an obviousness determination, the factual question of motivation to combine prior art is material to patentability, and cannot be resolved on subjective belief and unknown authority.” (Emphasis added) “In an obvious determination under patent law, it is improper, in determining whether a person of ordinary skill would have been led to combine references, simply to use that which the inventor taught against its teacher; thus, the Board of Patent Appeals and Interferences must not only assure that the requisite findings are made, based on evidence of the record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” (Emphasis added)

As further stated in the opinion, “In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board of Patent Appeals and Interferences are presumed to act from the viewpoint of a person having ordinary skill in the art to which the subject matter pertains; thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record and the failure to do so is not consistent with either effective administrative procedure or effective judicial review....” “In the context of an obvious determination, the Board of Patent Appeals and Interferences cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies....” “Sound administrative procedure requires that an agency apply the law in accordance with statute and precedent; the agency tribunal must make findings of relevant facts, and present its reasoning in sufficient detail that the court may conduct meaningful review of the agency’s action

Specifically, the Federal Circuit stated as follows “...**The foundation of the principal of judicial deference to the rulings of agency tribunals is that the tribunal has specialized knowledge and expertise, such that when reasoned findings are made, a reviewing court may confidently defer to the agency’s application of its knowledge in its area of expertise. Reasoned findings are critical to the performance of agency functions and judicial reliance on agency competence.**” (Citations omitted) “The ‘common knowledge and common sense’ on which the Board relied in rejecting Lee’s application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfil the agency’s obligation. This court explained in Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697, that ‘deficiencies of the cited references cannot be remedied by the Board’s general



conclusion about what is ‘basic knowledge’ or ‘common sense.’ The Board’s finding must extend to all material facts and must be documented on the record, least the ‘haze of so-called expertise’ acquire insulation from accountability. ‘Common knowledge and common sense,’ even if assumed to be derived from the agency’s expertise, do not substitute for authority when the law requires authority. (Citations omitted)

Applicant respectfully submits that, like the Board in In re Lee, by essentially saying that to combine the elements of the references, without a detailed explanation as to why or how, was ‘common knowledge and common sense’ and that such **is not** a substitute for **authority when the law requires authority**. Consequently, applicant respectfully requests that the Examiner provide the authority in the form of the above requested affidavit or additional reference/detailed explanation which provide the detailed explanation as to how the requirement of a wireless circuit, the speaker, the wireless circuit and the microphone being operatively housed in one of the first or the second portion wherein the device is capable of operatively linking the wireless circuit to a cell phone.

It is applicant's position that the Examiner has not and cannot provide acceptable reasoning why the specific combination, as now required by the amended claims, are obvious without some documented evidence, **what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination** to support the asserted "**obviousness**" and an action acknowledging same as respectfully requested.

As is known, it is incumbent upon the Examiner to present all the elements of a prima facie case of obviousness. Thus, the Examiner must explain why the prior art appeared to show the claimed subject matter and not simply the general aspects of the invention. Further, the Federal Circuit has added that when more than one reference or source of prior art is required in establishing the obviousness rejection “it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claim substitution or other modification.” [See, In re: Lalu, 747 F.2d 703, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984)] Thus, it is not enough that the Examiner present references that contain the assorted features of the invention.

The Examiner must also show **why** it would appear that the references would have been combined. [See also, In re: Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)] This the Examiner has not done and cannot do as it is believed that there is no disclosure, suggestion or teaching in either of the applied references to combine the applied references to produce the now claimed device and an action acknowledging same is respectfully requested.

It is applicant's position that the Examiner has not and cannot provide acceptable reasoning why the specific combination of features, as now required by the amended and the new independent claims, would have been obvious to one of ordinary skill in the art (design choice).

At this point, applicant respectfully **requests, that the Examiner** provide additional documented proof or an affidavit under Section 1.104(d)(2) with respect to the above rejections or any portions thereof that lack an appropriate administrative record showing the evidence on which the findings are based, accompanied by the agency's **reasoning** in reaching its conclusions rather than what appears to be rejections for "being a matter of design choice," "personal knowledge" and/or the taking of "official notice" and an action acknowledging same as respectfully requested.

### **New Independent Claims 8 and 9**

Applicant has added new independent claims 8 and 9 with new independent claims 8 and 9 being a combination of amended claim 1 and original claim 7. Applicant believes that this particular combination of features is clearly not disclosed, suggested or taught by the applied reference and thus the Examiner can not make a prima facie case of either anticipation or obviousness with respect to the new independent claims. In that regard, applicant respectfully submits that the new independent claims (8 and 9) are clearly allowable and an action acknowledging same is respectfully requested.

## CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 19-0153.

Date: December 17, 2008

Respectfully submitted,

/Arlen L. Olsen/

Arlen L. Olsen  
Registration No. 37,543  
Customer No. 05409

Schmeiser, Olsen & Watts  
22 Century Hill Drive, Suite 302  
Latham, New York 12110  
Tel. (518) 220-1850  
Fax: (518) 220-1857  
Email: aolsen@iplawusa.com